

REMARKS

Further and favorable reconsideration is respectfully requested in view of the foregoing amendments and remarks.

Specification Amendments

Page 3 of the specification has been amended to address the objection by the Examiner. Withdrawal of the objection is thus respectfully requested.

Patentability Arguments

The patentability of the present invention over the disclosures of the references relied upon by the Examiner in rejecting the claims will be apparent upon consideration of the following remarks.

Double Patenting Rejection

Claims 1-18 and 27-29 are provisionally rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1 and 3-31 of copending Application No. 10/536,194.

This rejection is respectfully traversed.

The processes of Applicants' claims are patentably distinct from the claimed processes of the reference application. Specifically, each of Applicants' step 2 "mixing of olivine particles with water", step 4 "removal of coarse mineral impurities", step 5 "separation of the precipitated silica from the mother Solution", step 6 "mechanical treatment of the separated silica", step 7 "preparation of a low viscosity slurry by adding sodium aluminate or other suitable aluminate", and step 8 "ageing the low viscosity slurry" (as set forth in Applicants' claim 1) is distinct from the steps of the reference claims. Applicants respectfully assert that the process of the present invention and the process of the reference claims are two different, parallel processes for making silica with a specific surface area.

Furthermore, the Examiner acknowledges that the reference application fails to specify the temperature of the ageing process. The Examiner makes the general statement that one of ordinary skill in the art would have known to optimize the temperature range for the ageing

process. However, Applicants kindly assert that this position is merely a conclusory statement, with no supporting evidence. As stated by the Court of Appeals for the Federal Circuit, “rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” See *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006).

Furthermore, a particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation. *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977). The Examiner has failed to describe how the temperature range for the ageing process is recognized as a result-effective variable. Accordingly, the assertion that one of ordinary skill in the art would have optimized the temperature range is untenable.

For the reasons provided above, it is clear that the double patenting rejection over copending Application No. 10/536,194 is untenable, and should be withdrawn.

Rejections Under 35 U.S.C. § 102 and 35 U.S.C. § 103

Claims 1-18 and 27-29 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Olerud (US 5,780,005) in view of Jas (US 4,537,699) in combination with Bomal et al. (5,800,608) or Bomal et al. (5,876,494).

This rejection is respectfully traversed.

Applicants respectfully request that the Examiner reconsider the arguments set forth in the prior response. (Please see pages 1-4 of the response filed May 9, 2011.)

Applicants previously argued that Olerud fails to teach removal of un-wanted particles **after** leaching. On page 5 of the outstanding Office Action, the Examiner states that the question of removal of the contaminants before or after the acid leaching step would have been obvious as a matter of choice, and refers to column 6, lines 10-20 of Olerud. However, it is unclear to what Olerud refers in this passage, since the reference initially discusses separation of several qualities of silica, with more or less “contaminated particles”. Contrary to the Examiner’s implication, the reference is certainly not discussing removal of contaminating sand product.

Furthermore, even assuming *arguendo* that Olerud suggests removing impurities both before and after leaching, this process would certainly be less effective than Applicants' process.

Additionally, the Examiner argues on in the paragraph spanning pages 5 and 6 of the Office Action that olivine is a silicate compound. However, Applicants respectfully note that olivine is a magnesium iron silicate with the formula $(\text{Mg,Fe})\text{SiO}_3$, which is totally different from the sodium silicate mentioned by Jas and Bomal.

For the reasons set forth in the previous response, as well as the comments provided above, Applicants respectfully assert that the subject matter of the pending claims is patentable over the cited combination of references. Reconsideration and withdrawal of the rejection are respectfully requested.

Claims 1-18 and 27-29 are rejected under 35 U.S.C. § 102(a) / 35 U.S.C. § 103(a) as being unpatentable over WO 2004/048264.

This rejection is respectfully traversed.

WO '264 is available under 35 U.S.C. § 102(a) as of its publication date of June 10, 2004, which is after Applicants' priority date of January 14, 2004. A certified copy of Applicants' priority document (which is in the English language) is present in the Image File Wrapper for the present application. Accordingly, Applicants respectfully assert that WO '264 is not available as prior art under 35 U.S.C. § 102(a) over the present application.

For this reason alone, it is respectfully requested that the 102(a)/103(a) rejection be withdrawn.

However, for purposes of expediting prosecution, Applicants also provide the following additional comments.

Although not acknowledged by the Examiner, WO '264 is also available as prior art under 35 U.S.C. § 102(e) as of its international filing date of November 27, 2003. Since the Examiner did not set forth a rejection based upon this statutory ground (§102(e)), if the Examiner chooses to reject Applicants' claims on this ground in a future rejection, it is respectfully requested that such a rejection be non-final.

Applicants respectfully assert that the claims of the present invention are neither anticipated, nor rendered obvious, over the teachings of WO '264. The Examiner admits (on

page 7, lines 5-6 of the Office Action) that WO '264 fails to specify the temperature of the ageing step. A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). In view of the Examiner's admission, it is clear that WO '264 fails to teach each and every element of Applicants' claims. Thus, Applicants' claims are clearly not anticipated by WO '264.

Furthermore, the Examiner makes the general statement that one of ordinary skill in the art would have known to optimize the temperature range for the ageing process. However, Applicants kindly assert that this position is merely a conclusory statement, with no supporting evidence. As stated by the Court of Appeals for the Federal Circuit, "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *See In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006).

Furthermore, a particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation. *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977). The Examiner has failed to describe how the temperature range for the ageing process is recognized as a result-effective variable. Accordingly, his assertion that one of ordinary skill in the art would have optimized the temperature range is untenable. Thus, the Examiner's position regarding obviousness has been overcome.

For the reasons provided above, it is clear that the subject matter of Applicants' claims is neither anticipated nor obvious over the teachings of WO '264.

Conclusion

Therefore, in view of the foregoing amendments and remarks, it is submitted that each of the grounds of objection and rejection set forth by the Examiner has been overcome, and that the application is in condition for allowance. Such allowance is solicited.

If, after reviewing this Amendment, the Examiner feels there are any issues remaining which must be resolved before the application can be passed to issue, the Examiner is respectfully requested to contact the undersigned by telephone in order to resolve such issues.

Respectfully submitted,

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